

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the October 8, 2002 Office Action. In such Office Action, claims 1-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Hunter (U.S. Patent No.6,138,832) and Williams (U.S. Patent No. 4,557,971). In Response, Applicant has amended page 5 of the specification to remove any discussion of the tape of the present invention including such phrases as "fragile" or "open first". With respect to the claims, Applicant respectfully traverses this rejection and provides the following argument in support of this traversal. Reexamination and reconsideration of the application, as amended, is respectfully requested.

CLAIM REJECTIONS

The present invention resides in pre-printed boxing tape which allows an individual to tape, label and organize boxes in one convenient step. As described in the Background section of the present application, the present invention is intended to overcome the disadvantages associated with using a marker or writing instrument to write the contents of the box or the room from which it was packed on the box itself, or using labels.

As discussed in the Background section, writing on the box, or tape, may present handwriting which is not legible or too small to be seen at a distance. Also, the writing may be smeared by other boxes or the movers themselves. Once a box is written upon, either the box must be packed in the future according to the information previously written on them, or the previous writing must be scratched out. Another problem with using a marking pen is that the marking pen must be purchased in

addition to the tape, and the tape and marking pen must be located with one another at all times. During a confusing and complicated moving process, this can become quite aggravating.

With respect to existing moving labels, once again the consumer must purchase these labels in addition to the boxing tape. Also, these labels are very small rendering them difficult to read at a distance. Additionally, the labels must be applied to several surfaces of the box so that a mover must determine where the box originated without having to look at every side of the box.

The present invention overcomes these problems by pre-printing indicia on the boxing tape which is permanent so as not to smudge, smear or otherwise become illegible. Instead of throwing away the boxes or scratching out the old labels or markings, the tape is simply removed from the boxes and the boxes are stored for later use. The present invention also eliminates the need to purchase marking pens, labels, and boxing tape to individually wrap and mark each box.

As will be discussed more fully below, neither Hunter et al. nor Williams recognized these problems or provide the necessary solutions that the present invention claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See MPEP §2143.

With reference to MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 18 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Independent claim 1 recites a packaging tape system comprising an adhesive tape configured to extend across the face of a box and seal two flaps of the box in a closed position. Indicia is pre-printed on the adhesive tape indicating a room or location in a house or office from which the contents of the box originated. (Emphasis added). As recited in dependent claims 2 and 3 and independent claim 6, the adhesive tape is preferably formed in multiple dispensing rolls, each roll being of a distinctive color so as to be readily visually distinguishable from one another and for indicating another room or location within the house or office.

As recited in dependent claims 4, 5, 7 and 8, the pre-printed indicia specifies at least one of a bedroom, a bathroom, a kitchen, a dining room, a living room, a garage, a storage room, an office, a study, a den, a family room, a utility room, a break room, a conference room, a file room, a reception area, an office, a computer or a department so as to indicate the room or location in the house or office.

Claims 9-16 recite the process for packaging articles to be moved using the pre-printed adhesive tape discussed above.

In contrast, Hunter et al. relates to a packing kit which includes at least one packing container, means for securing the containers in its constructive position, wrapping materials, and at least one inscribing means, in the form of a felt-tip marker or permanent marker. It is notable that each of the independent claims of the Hunter

et al. patent recite the limitation of including an inscribing means. In column 4, lines 12-16, it is described that the markers are any indelible or other marker, pen, pencil, crayon, felt-tip pen or the like. It is also discussed that the kit may include pre-printed labels or even a label maker.

The packing kit of Hunter et al. actually discloses the very problems associated with the prior art, discussed in the Background section of the present application which the present invention is intended to overcome. Namely, the use of a marking instruments or labels when packing boxes.

The Hunter et al. patent does not disclose adhesive tape having pre-printed indicia thereon indicating a room or location in a house or office from which the contents of the box originated. As detailed in MPEP §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed.Cir. 1983). Considered as a whole, the packing kit of Hunter et al. does not render the present invention obvious.

As stated by the Federal Circuit, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *WL Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed.Cir. 1983). The fact that the packing kit of Hunter et al. includes an inscribing means, in the form of a marker 14, leads away from the claimed present invention which is intended to eliminate the need for such a marker, and all the problems associated therewith.

In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomya et al.*, 184 USQP 607, 612-613 (CCPA 1975).

The Office Action properly admits that the Hunter et al. reference does not teach the tape having pre-printed indicia identifying rooms of a house such as the term "bedroom", and "bathroom". The Office Action asserts that Williams teaches of a self-adherable tape comprised of a pre-printed message such as "handle with care" or "fragile". The Williams patent discloses a multiple layered markable and self-adherable tape. The permeable layer thereof provides a suitable surface for printing or marking. It is notable that the Williams reference was issued in 1985, and the Hunter et al. reference was filed in July of 1998. Thus, the multiple layered tape was in the public domain at the time of the Hunter et al. invention. However, Hunter et al. do not disclose the use of multiple layered laminated tape, nor of printing upon their adhesive tape (16), instead electing to include labels or a marker 14.

Moreover, the Williams reference does not disclose that the pre-printed indicia indicate a room or location in a house or office from which the contents of the box originated. Instead, only the phrases "handle with care" and "fragile" are discussed. The combination of the Hunter et al. and Williams references, considered as a whole, do not arise to the present invention. Once again, the Williams reference does not appreciate the existence of the problem solved by the present invention, which is, in itself, strong evidence of the non-obviousness of the invention. Further, the multiple layered tape of Williams is described and claimed as providing a surface suitable to be written upon. Such disclosure teaches away from the present invention.

Page 5 of the Specification of the present application has been amended to remove all reference to any other pre-printed indicia other than room or location identifying indicia. Although such limitations were not included in the claims, Applicant removes such from the Specification in order to clarify that the pre-printed indicia is directed to the office or home location from which the contents of the box originated.

As discussed above, to establish *prima facie* obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. Neither Hunter et al. nor Williams disclose pre-printed indicia on adhesive tape which indicates a room in a house or office from which contents of the box originated. As such, independent claims 1, 6, 9 and 14 are not rendered obvious by the cited references. If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. *MPEP §2143.03; In re Fine*, 5 USPQ 2d 1596 (Fed. Cir. 1988).

In particular, with reference to dependent claims 4, 5, 7, 8, 10, 11, 15 and 16, neither Hunter et al. nor Williams disclose pre-printed indicia relating to the specific rooms and locations of the house or office recited in these claims.

With respect to claims 3, 6, 13 and 14, neither Hunter et al. nor Williams disclose the use of multiple dispensing rolls of adhesive tape having distinctive colors so as to be readily visually distinguishable from another roll indicating another room or location of the house or office.

An Internet printout from the www.yellowtruck.com web-site was cited, but not used as a reference. The packing tape disclosed in such web-site is actually provided by Applicant itself, and indicated as serving the purpose of taping and marking a box in just one step. Applicant has found a need in the market place for such a tape and many rental agencies and storage companies have recently begun to offer Applicant's tape.

CONCLUSION

From the foregoing arguments, Applicant submits that pending claims 1-16 are not rendered obvious by the Hunter et al. and Williams references, and are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

KELLY BAUERSFELD LOWRY & KELLEY, LLP



Aaron T. Borrowman
Registration No. 42,348

ATB/kr
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the specification:

On page 5, first full paragraph, lines 6-20 has been amended as follows:

[It is also contemplated that roles of tape bearing the word "fragile", or "open first" be produced. Thus, those boxes from which ever room of the house or office having fragile articles therein can be also taped with the roll of tape bearing the repeated word "fragile". Alternatively, a small portion of the tape can be cut and placed on one or more sides of the box. Similarly, it is not uncommon that certain boxes should be opened before others. For example, those containing perishable items, items which need to be used in the first twenty-four hours after moving, such as towels, toiletries, cooking utensils, etc., can be labeled with the "open first" tape. This tape can either be clear, or color coated, as meets the requirements of the mover.] Preferably, the invention is supplied as a kit which would include multiple rolls of tape so that a mover could purchase the kit and have at least one roll of tape for each room of the house[, as well as the option of the "fragile" and "open first" rolls of tape]. Of course, the rolls of tape embodying the present invention could be sold individually or in groups as deemed necessary.